

REMARKS/ARGUMENTS

Favorable consideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 3-10, and 12-18 are pending in the application, with Claims 1, 4 and 13 amended by the present amendment.

In the outstanding Office Action, Claims 1, 3, 10, 12, and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chestnut (U.S. Patent No. 6,041,114) in view of Perkins (U.S. Patent No. 6,614,889); and Claims 4, 5, 7, 9, 13, 14, 16, and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chestnut in view of Alfred et al. (U.S. Patent No. 5,894,504, hereinafter Alfred).

Independent Claims 4 and 13 are amended to more clearly describe and distinctly claim Applicants' inventions. Support for this amendment is found in Applicants' originally filed specification.¹ No new matter is added.

Briefly recapitulating, previously presented Claim 10 is directed to a communication method used for carrying out call forwarding by a communication system. The method includes (a) receiving a call establishment request from a communication terminal; (b) sending, to said communication terminal, a call forwarding destination information including information on at least a call forwarding destination; (c) receiving information on a call forwarding destination which is selected by a caller from said communication terminal, and allowing said communication terminal and said call forwarding destination to communicate with each other according to said information on said call forwarding destination, and; (d) establishing a communication mode between said communication system and said communication terminal. *The communications mode is drawn from a list of at least three*

¹ Specification, page 11, lines 22-34.

possible communications modes according to said information on said call forwarding destination. The at least three communications modes comprises an email mode, a fax mode, and a chat mode. Previously presented Claim 1 is directed to an apparatus corresponding to the method of Claim 10. The claimed method and corresponding apparatus improves on the prior art because it allows callers to select a call forwarding destination and a call forwarding mode.²

Chestnut discloses a method and device for callers to select a call forwarding destination phone number or mail box from a menu presented by a call forwarding manager.³ However, as noted by the Examiner, Chestnut does not disclose or suggest a method or a device for callers to select a call forwarding destination and a communications mode comprising a chat mode as recited in amended Claims 1 and 10. Chestnut also does not disclose or suggest communicating according to a communications mode drawn from a list of at least three possible communications modes, as recited in amended Claims 1 and 10.

Perkins discloses a switching device configured to switch one phone line between multiple devices, including a computer and a fax machine.⁴ However, like Chestnut, Perkins does not disclose or suggest a method or a device for callers to select a call forwarding destination and a communications mode comprising a chat mode as recited in amended Claims 1 and 10. Perkins also does not disclose or suggest communicating according to a communications mode drawn from a list of at least three possible communications modes, as recited in amended Claims 1 and 10.

As none of the cited prior art, individually or in combination, disclose or suggest all the elements of independent Claims 1 and 10, Applicants submit the inventions defined by

² Specification, page 1, lines 28-34.

³ Chestnut, column 5, lines 26-62.

⁴ Perkins, abstract, Figure 1.

Claims 1 and 10, and all claims depending therefrom, are not rendered obvious by the asserted prior art for at least the reasons stated above.⁵

Furthermore, Chestnut explicitly and exclusively recites that voice calls are routed to voice-capable devices and facsimile calls are routed to facsimile-capable devices.⁶ Similarly, Perkins discloses that voice calls are switched to voice-capable devices, facsimile calls are switched to facsimile-capable devices, and data calls are switched to data-capable devices.⁷ Thus, Applicants submit that both Chestnut and Perkins each disclose away from Applicants' claimed invention.

Regarding modes, Perkins discloses several.⁸ For example, Mode 1 is "modem connected to communication line, fax disconnected". The mode of connection in Perkins apparently means a pattern of connection between devices. In contrast, the claimed communication mode is to be established between the communication system and the communication terminal, and is not a connection pattern between devices. Thus, there is no relation between the switching device of Perkins and the claimed feature of "establish[ing] a communication mode between said communication system and said communication terminal according to said information one said call forwarding destination". Thus, Applicants submit that even if the different modes of Perkins were to be incorporated into Chestnut, the combination would equate to Applicants' claimed communication mode between the terminal and the destination since the claimed communication mode is not a connection pattern between devices.

⁵ MPEP § 2142 "...the prior art reference (or references when combined) must teach or suggest **all** the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

⁶ Chestnut, column 10, lines 43-54.

⁷ Perkins, Figure 3.

⁸ Perkins, column 5, lines 1-43.

Amended independent Claim 13 is directed to a communication method used for carrying out call forwarding by a communication system. The method includes (a) receiving a call establishment request from a communication terminal; (b) sending, to said communication terminal, a call forwarding destination information including information on at least a call forwarding destination; (c) receiving information on a call forwarding destination which is selected by a caller from said communication terminal; (d) performing media conversion between communication modes of said call forwarding destination and said communication terminal; and (e) allowing said communication terminal and said call forwarding destination to communicate with each other. *The step of media conversion includes conversion modes drawn from a list of at least two possible modes, said at least two possible modes including voice-to-text conversion and text-to-voice conversion.* The step of performing media conversion occurs while said communication terminal and said call forwarding destination communicate with each other. Amended Claim 4 is directed to an apparatus corresponding to the method of Claim 13. The claimed method and corresponding apparatus improves on the prior art because it allows callers to select a call forwarding destination and a call forwarding mode.⁹

As noted above, Chestnut discloses a method and device for callers to select a call forwarding destination phone number or mail box from a menu presented by a call forwarding manager.¹⁰ As noted in the Official Action, Chestnut does not disclose or suggest speech-to-text conversion or text-to-speech conversion. Alfred discloses speech-to-text conversion.¹¹ However, Chestnut explicitly and exclusively recites that voice calls are routed either to voice-capable devices and facsimile calls are routed to facsimile-capable devices.¹²

⁹ Specification, page 1, lines 28-34.

¹⁰ Chestnut, column 5, lines 26-62.

¹¹ Alfred, Figure 4.

¹² Chestnut, column 10, lines 43-54.

That is, there is no reference or suggestion in Chestnut to route facsimile calls to voice-capable devices or voice calls to facsimile devices. Thus, there is no motivation in Chestnut that would lead one skilled in the art to consider cross-routing signals between voice and image domains.

More importantly, Chestnut is limited to voice and facsimile communications. That is, there is no reference in Chestnut of any type of text-based communications. Applicants traverse the assertion by the Examiner that facsimile communications are text-based communications. Facsimile communications are image-based communications where the image may or may not include an image of text. However, transmission of an image of text is not text-based communications. Thus, the combination of Chestnut and Alfred would result in a speech-to-facsimile feature, not a speech-to-text feature as recited in Applicants' Claims 4 and 13. In addition, the combination of Chestnut and Alfred could not result in a text-to-speech feature as recited in Applicants' Claims 4 and 13.

As none of the cited prior art, individually or in combination, disclose or suggest all the elements of independent Claims 4 and 13, Applicants submit the inventions defined by Claims 4 and 13, and all claims depending therefrom, are not rendered obvious by the asserted prior art for at least the reasons stated above.¹³ Furthermore, for the above reason, Applicants submit there is no motivation to combine the disclosures of Alfred and Chestnut and that the rejections based on the combination of Alfred and Chestnut constitutes an impermissible hindsight reconstruction of Applicants' claimed inventions. Furthermore, because Chestnut does not disclose any text communications mode, one cannot simply add

¹³ MPEP § 2142 "...the prior art reference (or references when combined) must teach or suggest **all** the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

the speech/text conversion of Alfred to Chestnut and arrive at Applicants' claimed inventions.

Furthermore, the Official Action suggests that Chestnut discloses a media conversion part since the disclosed telecommute server instructs a PBX to forward a call to a telephone extension or a voice messaging system. The Official Action further seems to suggest that the telecommute server Chestnut is equivalent to Applicants' claimed media conversion part. However, Applicants' claimed media conversion part is a part via which the communication terminal and the call forwarding destination communicate with each other while performing media conversion. In contrast, in Chestnut when a call is forwarded to the voice messaging system, a calling party and a call forwarding destination do not communicate with each other. Thus, Applicants submit that Chestnut does not suggest Applicants' claimed media conversion part. That is Chestnut fails to disclose Applicants' claimed *step of performing media conversion occurs while said communication terminal and said call forwarding destination communicate with each other*. Since Chestnut does not disclose or suggest the claimed media conversion part, the speech recognition system of Alfred cannot be incorporated into Chestnut.

Thus, for another reason, Applicants submits there is no motivation to combine the disclosing of Alfred and Chestnut. Therefore, Applicants submit the rejections based on the combination of Alfred and Chestnut constitutes an impermissible hindsight reconstruction of Applicants' claimed inventions.

Application No. 09/987,550
Reply to Office Action of March 23, 2004

Accordingly, in view of the present amendment and in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073
Michael E. Monaco
Registration No. 52,041

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
BDL/MEM/kkn

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